II. REMARKS

A. Status of the Claims

Claims 6-7, 13-16 and 24-30 are currently pending. Claims 1-5, 9-12, 17-23 have been cancelled without prejudice. New claims 25-30 have been added. Claims 6 and 24 have been amended without prejudice. Support for these amendments can be found specifically in Table 14 on page 30, in originally filed claim 21 and in the Examples of the specification. Support for new claims 25-30 can be found in the specification, e.g. in Table 15 on page 32 and Table 16 on page 33. It is respectfully submitted that no new matter has been added by virtue of this amendment.

B. Claim rejection under 35 U.S.C. §103

1. Goldie et al.

In the Office Action, the Examiner rejected claims 6-8, 13-16, 21 and 24 under 35 U.S.C. §103(a) over Goldie et al. (U.S. 4,844,909).

In the Office Action, the Examiner stated that "the peak plasma range of Goldie et al. overlaps with that claimed (Goldie et al. teaches 2-4 hours)". Applicants respectfully disagree with the Examiner's position and submit that 2-4 hours does not overlap with 4-8 hours. However, in order to further the prosecution of the present application, the claims have been amended to recite that the dosage form provides a peak plasma level of hydromorphone obtained in-vivo which occurs between 4.42 to 8 hours after administration. Applicants respectfully submit that the range of between 4.42 to 8 hours does not overlap with, and is neither taught nor suggested by, the range in Goldie of 2 to 4 hours.

Additionally, the Examiner stated that:

> ...even if between 2 and 4 hours is not considered inclusive of 4 hours, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize a dosage form with a peak plasma level obtained between 4 and 8 hours after administration

> of the dosage form because Goldie et al. teaches that dosage forms achieving a peak plasma level between 2 and 4 hours are, surprisingly, interchangeable with dosage forms that achieve peak plasma levels between about 4 and 8 hours after administration.

Applicants respectfully submit that the Examiner is misstating what is taught by Goldie. The pertinent portion of the Goldie reference the Examiner relies upon states:

> In order to obtain a controlled release ***drug*** dosage form having at least a 12 hour therapeutic effect, it is usual in the pharmaceutical art to produce a formulation that gives a peak plasma level of the ***drug*** between about 4-8 hours after administration (in a single dose study). The present invention has surprisingly found that, ***in the case of hydromorphone***, a peak plasma at between 2-4 hours after administration gives at least 12 hours of pain relief and, most surprisingly, that the pain relief obtained with such a formulation is greater than that achieved with formulations giving peak plasma levels (of hydromorphone) in the normal period of 1-2 hours after administration.
> Goldie et al. at column 2, lines 14-26 (emphasis added).

Applicants respectfully point out that this statement in the Goldie reference refers to a formulation which has a peak plasma level of about 4-8 hours for a "drug" and is not specific to hydromorphone. Further, this statement is with respect to a 12 hour formulation and not with respect to the claimed methods of providing a 24 hour effect. Goldie does not suggest hydromorphone formulations providing a time to peak plasma level of about 4-8 hours, nor does Goldie teach a therapeutic effect of 24 hours as recited in the present claims.

Further, the Goldie reference does not state that "dosage forms achieving a peak plasma level between 2 and 4 hours are, surprisingly, interchangeable with dosage forms that achieve peak plasma levels between about 4 and 8 hours after administration" as suggested by the Examiner.

Applicants further submit that in view of the Goldie reference, one skilled in the art would not be motivated to administer the dosage form disclosed therein "at a dosing interval of about 24 hours."

"[A] proper analysis under § 103 requires, inter alia, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success." Noelle v. Lederman, 355 F.3d 1343, 1352 (Fed. Cir. 2004), citing In re Vaeck, 947 F.2d 488, 493 (Fed. Cir. 1991).

In view of the this analysis, Applicants respectfully refer the Examiner to the Goldie reference at column 2, lines 4-10, which recites that although the Goldie formulations "give peak plasma levels of hydromorphone between 2 and 4 hours after administration, they still afford therapeutic levels of hydromorphone in vivo over at least a 12 hour period, and may therefore be used on a ***twice daily basis***." (Emphasis added.) Given this teaching of the Goldie reference, Applicants respectfully submit that one skilled in the art would not be motivated to administer the formulations disclosed therein at a dosing interval of about 24 hours.

In support of the Examiner's position, the Examiner noted that "the exemplified clinical studies teach plasma levels at 24 hours wherein the amount present is a therapeutically effective amount because (1) the dosage form is taught to be therapeutically effective for at least 12 hours and the plasma levels at 24 hours are not significantly different than the plasma levels at 12 hours; and (2) the plasma levels are within the scope of the plasma levels as instantly claimed in claim 20." However, the Examiner appears to be ignoring the fact that the Goldie reference (i) makes no mention of administering the dosage form on a once daily basis to achieve at least a 24 hour therapeutic effect, (ii) only describes a twice daily administration and (iii) makes no mention of the plasma level at 24 hours which would be considered to be therapeutically effective. Therefore, Applicants submit that, regardless of the exemplified clinical studies, the

Goldie reference that would motivate one of ordinary skill in the art to administer the Goldie formulation at a 24 hour interval as recited in the present claims.

In view of the above, Applicants respectfully request that the rejection under 35 U.S.C. §103(a) be removed.

III. CONCLUSION

In view of the amendments made and arguments presented, it is respectfully requested that the Examiner's rejections be withdrawn. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

An early and favorable action on the merits is earnestly solicited.

Respectfully submitted,
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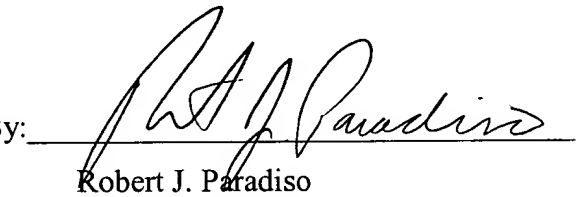
By: 

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